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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,954	08/28/2001	Ulrich Meisen	Mo-6419/LcA 34,865	5188
34947	7590	10/24/2003	EXAMINER	
BAYER CHEMICALS CORPORATION 100 BAYER ROAD PITTSBURGH, PA 15205			RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	19
DATE MAILED: 10/24/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,954

Applicant(s)

MEISEN, ULRICH

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 4 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18. 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 September 2003 has been entered.

Terminal Disclaimer

The terminal disclaimer filed on 9 September 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of a patent granted on US application 09/944880 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Specification

The amendment filed 16 December 2002 remains objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the content of Mn as being determined by ICP-OES (spec. p. 9). The specification as filed states that the content of Mn is determined by atomic absorption spectroscopy.

In order to make this change applicants must show that the specification as originally filed 1) was in error in the description of how the amount of Mn is determined and 2) that the

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proposed correction would have been obvious to one of skill in the pertinent art. It is apparent from applicant's remarks that correction is believed to be warranted. Although the amount of Mn may be the same by either measurement technique as discussed, applicant must show possession of ICP-OES as the measurement technique for Mn analysis. This is done by showing both factors noted above. If such a showing is made persuasively, the change would be permitted. However, the application history as currently presented does not warrant such a change because it is not apparent that Mn cannot be determined by atomic absorption spectroscopy and not established that ICP-OES is the measurement technique for Mn analysis.

Applicant is required to cancel the new matter in the reply to this Office Action.

The misspelling of "silicon" in the Abstract must be corrected in response to this Office action.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Okano *et al.* in US Patent 5,578,375 or Taya *et al.* in US Patent 5,296,325.

Okano discloses granular magnetite particles having a specific percentage of aluminum in the mineral's lattice but no silicon is present in the preparation of the magnetite (see Examples 1-23). Because no silicon is disclosed as or in a magnetite reactant, it appears that the amount of silicon inherently would be extremely small, such as a trace amount, which would fall within the scope of the instant claims' "low-silicon magnetite". As such, the magnetite

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appears to inherently fall within the scope of the claimed magnetite. Okano discloses this magnetite for use in magnetic toners (col. 1, l. 11-15).

Similarly, Taya discloses a magnetite for a magnetic toner that is formed without any silicon-containing reactants (see col. 8, l. 29-52 & the Examples). Because no silicon is disclosed as or in a magnetite reactant, it appears that the amount of silicon inherently would be extremely small, such as a trace amount, which would fall within the scope of the instant claims' "low-silicon magnetite". As such, the magnetite appears to inherently fall within the scope of the claimed magnetite.

Allowable Subject Matter

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.


CHRISTOPHER RODEE
PRIMARY EXAMINER

cdr
21 October 2003